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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,169	01/02/2001	Cy A. Stein	55669-A-PCT-US/JPW/GJC	9695

7590 09/02/2004
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EXAMINER

GIBBS, TERRA C

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

942

Advisory Action

Application No.

09/753,169

Applicant(s)

STEIN ET AL.

Examiner

Terra C. Gibbs

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 5,9 and 43.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). May 10, 2004.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendment will not be entered because it raises new issues that would require further consideration and/or search, including 35 U.S.C. 112, first paragraph issues for new matter. For example, in the proposed amendment, claims 5 and 9 have been amended to recite, "a composition of matter". The phrase "a composition of matter" is a new matter issue as the phrase cannot be found in the instant specification as filed. The proposed amendment indicates that support for claims 5 and 9 can be found at page 3, lines 3-5, page 5, lines 20-25, 3, and 28, page 15, lines 20-25, page 1, lines 21-22, and originally filed claim 1. However, referring to these pages and originally filed claim 1, the Examiner cannot find support for the phrase "a composition of matter". Thus, Applicant's proposed amendment would necessarily require a new search to be performed for a composition of matter comprising an antisense oligonucleotide comprising 10 or more contiguous bases of the nucleotide sequence set forth in any one of SEQ ID NOs: 1 and 3-13 as recited in claims 5 and 43 or for a composition of matter comprising an antisense oligonucleotide consisting of the nucleotide sequence set forth in SEQ ID NO:2 as recited in claim 9.

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicant's reply has overcome the following rejection(s): If entered, Applicant's amendment would overcome the 35 U.S.C. 112, first paragraph rejection against claim 43 for enablement. If entered, Applicant's amendment would overcome the 35 U.S.C. 112, first paragraph rejection against claim 5 for written description. If entered, Applicant's amendment would not overcome the double patenting rejections against claims 5, 9, and 43 as being provisionally rejected under the judicially created doctrine of double patenting over claims 9, 36-50, 54, 54, 58, 61, and 62 of copending Application No. 09/832,648, in view of Manoharan et al., Sanghvi et al., Matteucci et al., and Arnold et al., or the provisionally rejected under the judicially created doctrine of double patenting over claims 37-43, 51-53, 58, 61, and 62 of copending Application No. 010/160,344. Applicants argue that the claims of the co-pending applications have not been allowed and if the rejections of record are obviated, then claims 5, 9, and 43 should be allowed. This is not found persuasive because if entered, the proposed amendment would raise new issues that would require further consideration and/or search. Further, the proposed amendment would raise a issue of new matter, since the phrase "a composition of matter" does not appear to be supported in the instant specification as filed.

Continuation of 5. does NOT place the application in condition for allowance because: The request addresses the claims as amended, however, the claims as amended, have not been entered on the record..

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